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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,878	02/22/2002	Kohki Katoh	219257US2	8566

22850 7590 07/24/2003

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

21

Office Action Summary

Application No.

10/079,878

Examiner

Christopher D RoDee

Applicant(s)

KATOH ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.

2b) ☐ This action is non-final.

- 2a) ☒ This action is FINAL.

- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) 9, 10 and 14-22 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-8 and 11-13 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

- 12) ☐ The oath or declaration is required in reply to this Office action.

If approved, corrected drawings are required in reply to this Office action.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

- a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other:

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Part of Paper No. 21

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DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of I, claims 1-8 and 11-13 in Paper No. 15 is acknowledged. The traversal is on the ground(s) that the inventions are directed to a method of making the toner or contain the toner and should not be separated. Applicants also state that there has been no reasons and/or examples presented to support patentable distinctness or that a burden exists should the claims be retained together. This is not found persuasive because MPEP §§ 806.05(f) and (h) recognize that restriction is possible when the same article or composition is present in the method of making claims and the method of using claims as is present in the article or composition claims. As long as the Examiner sets forth valid alternative methods of making and using the article or composition restriction is proper. The Examiner has met this requirement. Specific citations in the prior art are not required. Applicants have merely stated that the Examiner has not provided reasons and/or examples to support patentable distinctness, but this is not correct. The Examiner has provided alternative methods of making and using the toner and applicants have not specifically commented on these alternatives. Applicants have also not shown why the process as claimed cannot be practiced by hand nor have any reasons for such a position been submitted with respect to the apparatus and method of using claims. Applicants have also not specifically stated why the other various and detailed reasons for distinctness per MPEP §§ 806.05(d) and (e), 2114, and 2115 are improper. The mere position that the Examiner is essentially incorrect does not provide any specific reasons that properly traverse the restriction. Further, the Examiner has shown that a burden of examination exists because of the different classifications presented. The searches, which include each of these identified classifications, are not coextensive.

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Rejoinder will be considered when the toner claims are found allowable. However, the apparatus claims will not be rejoined because they do not represent a method of making or a method of using the claimed color toner. Only such claims are available for rejoinder.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

Each of the references submitted in the IDS submissions of 4/11/03, 6/12/03, and 6/20/03 have been considered. In response to the Examiner's comments in the last Office action, applicants have discussed the reasons for filing the large number of references in the instant application. However, applicants have not highlighted those documents of most significance to the instant claims, particularly to the claims directed to the elected invention, as requested in the last Office action.

Response to Amendment

The recent amendment to the specification deletes the descriptive matter in lines 28-31 of page 26. Although removal of the descriptive matter is not new matter, the Examiner suggests that a connecting passage be added to the specification that identifies the specific formulae as examples of the preferable metallic salts of the salicylic acid derivatives.

Claim Rejections - 35 USC § 103

Claims 1, 3, 5, 7, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anno *et al.* in US Patent 5,932,386 in view of Takezawa *et al.* in US Patent 6,485,876.

In response to this rejection as previously set forth, applicants have amended the claims specifying that the amount of the titania is 0.3 to 1.5 parts by weight of the toner. Applicants

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note that Anno's examples all use 0.2 parts by weight of the external titania. Additionally, applicants state that Anno does not disclose or suggest the claimed segregation rate. The supporting Takegawa reference is criticized as not disclosing the claimed amount of titania.

The Examiner has carefully considered applicants' remarks. A review of Anno does show that the examples each use 0.2 parts by weight of the external titania. However, the reference teaches that the fluidizing agent of the reference should preferably be used in amounts of from 0.1 to 1 percent by weight relative to the toner (col. 7, l. 24-30). Given the specific disclosure of 0.2 parts by weight titania per 100 parts of toner in the examples (i.e., just under 0.2 percent by weight) and a preferred titania range of 0.1 to 1 weight percent, the artisan would have found it obvious to include the titania in larger amounts, such as from the exemplified amounts up through and including 1 weight percent. A value of 1 weight percent titania per 100 parts of toner would equate to about 1 part by weight titania. Such a value falls squarely within the scope of the instant claims.

In response to applicants' arguments against the Anno and Takegawa references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Anno and Takegawa clearly teach each and every claim limitation when considered in combination. Specifically, Anno teaches the amounts of titania now claimed while Takegawa teaches the claimed segregation rate. The Examiner has provided specific reasons why the artisan would combine the references, but there are no remarks from applicants concerning the propriety of the combination or the motivation asserted in the initial rejection. The references are still seen by the Examiner as applicable to the claims as amended for the reasons given above and the reasons of record.

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Each and every limitation is suggested by the references as combined. The rejection is maintained as modified in response to the new claim limitations.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anno *et al.* in US Patent 5,932,386 in view of Takezawa *et al.* in US Patent 6,485,876 as applied to claims 1, 3, 5, 7, 8 and 12 above, and further in view of Katoh *et al.* in US Patent 6,303,258.

This rejection was applied in the last Office action and is modified for the reasons given above concerning the new material amount limitations for the titania. In addition to the reasons for traversal given above concerning Anno and Takezawa, applicants state that Katoh fails to disclose the claimed segregation rate and amount of titania.

The Examiner has given detailed consideration to the references and applicants' remarks but must maintain the rejection because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Katoh, Anno and Takegawa clearly teach each and every claim limitation when considered in combination, as is proper for this rejection. The rejection as modified in response to the new claim limitations is maintained. See remarks above for Anno in view of Takenzawa.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anno *et al.* in US Patent 5,932,386 in view of Takezawa *et al.* in US Patent 6,485,876 as applied to claims 1, 3, 5, 7, 8 and 12 above, and further in view of Eguchi *et al.* in US Patent 6,268,099.

This rejection was applied in the last Office action and is modified for the reasons given above concerning the new material amount limitations for the titania. In addition to the reasons for traversal given above concerning Anno and Takezawa, applicants state that Eguchi fails to disclose the claimed segregation rate and amount of titania.

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The Examiner will maintain the rejection because one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Anno, Eguchi, and Takegawa clearly teach each and every claim limitation when considered in combination, as is proper for this rejection. Anno specifically teaches amounts of externally added titania within the scope of the instant claims. The rejection as modified in response to the new claim limitations is proper and is maintained.

Claims 1, 3, 5-9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertrand *et al.* in US Patent 5,554,471 in view of JP 11-258847 and further in view of Otani *et al.* in US Patent 6,232,030.

This rejection was set forth in the last Office action. As discussed above, applicants have amended the claims to include an amount of externally added titania ranging from 0.3 to 1.5 parts by weight. Applicants traverse the rejection because Bertrand does not disclose the claimed segregation rate for titania in the amounts claimed. Applicants state that the segregation rate must be above 5 % because a specific mixing method is used to control segregation. The list of additives in column 14 also fails to disclose a titania having the claimed segregation rate. The supporting JP reference and Otani are criticized for not disclosing a titania having the claimed segregation rate or the claimed material amounts.

A review of Bertrand shows that the amount of the external additives blended with the toner is in a range of from about 0.1 to about 5 percent by weight, preferably from about 0.1 to about 1 percent by weight. (col. 14, l. 35-50). Example IV uses 1.1 percent of titania with each of the toners of Examples I-III. This amount appears to be based on the total weight of the tone. Thus, the artisan would expect the amount of the titania to about 1.1 parts by weight (considering the toner as 100 parts by weight). Such an amount is within the range of titania

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required by the claims as amended. Bertrand teach that the subtractive color pigments have a diameter particle size or agglomerate diameter size of from about 0.01 micron to about 0.3 micron, which falls within the scope of the instant claims (e.g., see claim 1).

The supporting references teach the claimed segregation rate for titania in toners for the reasons given in the last Office action (p. 9). Applicants have not specifically stated that the JP reference fails to disclose the claimed segregation rate. It is also unclear why Bertrand has a segregation rate above 5 %. There is no specific disclosure of the segregation rate in Bertrand nor indication that the mixing is conducted to address the segregation rate. In any event, the supporting JP reference teaches that the titania should have a segregation rate, such as 0.5 % or 1.0 %. These values fall within the scope of the instant claims.

The amounts of the titania in the JP reference, which discloses the claimed segregation rate, includes the amounts present in Bertrand's general disclosure (see JP ¶ [0035] and Bertrand col. 14) and Bertrand's Examples. Thus the JP reference is pertinent to toner compositions having titania in the amounts disclosed by Bertrand. The artisan would have found it obvious to use a titania external additive in Bertrand having a release rate within the values taught by the JP reference, such as the specifically recited 0.5 % or 1.0 %, because Bertrand exemplifies titania additives and the JP reference teaches that this feature as reducing irregularities in a contact printed image, gives more uniform charging, and reduces the likelihood that the titania will adhere to a device in the photocopier system (¶ [0006] - [0009]).

The references in combination disclose each feature of the claimed invention and provide specific reasons to combine the references in the manner proposed by the Examiner. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller* and *In re Merck & Co.*, *supra*. The

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rejection is seen as proper for the reasons given in the last Office action and the reasons given above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

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cdr
July 21, 2003



CHRISTOPHER RODEE
PRIMARY EXAMINER